

Remarks/Arguments

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Original claims 1, 3, 5, 6, 8, 17, 18, 23, 27, 39, 43, 44, 67, and 77 have been amended and claims 4, 13-16, 24-26, 28-38, 41, 42, 45, 46, 51-56, 61-66, 71-76, 79, and 80 have been canceled. Claims 2, 7, 9-12, 19-22, 40, 47-50, 57-60, 68-70, and 78 have been maintained in their original form and new claim 81 has been added.

Rejections under 35 U.S.C. § 102

Original independent claims 1, 39, and 77 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. US 2002/0055364 by Wang et al. ("Wang"). Applicant has amended claims 1, 39, and 77 and submits that these claims, as amended, are not anticipated by Wang. The PTO provides in MPEP § 2131 that, "[t]o anticipate a claim, the reference must teach every element of the claim." Therefore, with respect to claims 1, 39, and 77, to support a rejection under 35 U.S.C. §102(e), the Wang reference must contain all elements of the claim.

Claim 1, as amended, recites in part:

- one or more of the access points detecting that one or more of the dormant access terminals did not acknowledge receipt of the short data bursts;
- one or more of the access points re-assigning one or more of the non-acknowledging dormant access terminals to different corresponding common traffic channels; and
- one or more of the access points re-transmitting the short data bursts to one or more of the non-acknowledging dormant access terminals using the re-assigned common traffic channels.

Applicant submits that this is neither taught nor suggested by the Wang reference. Therefore, claim 1 should be allowable over Wang. Dependent claims 2, 3, 5-12, 17-

23, 27, depend from further limit the independent claim 1 and should therefore overcome any rejections based on the Wang reference as well.

Claim 39, as amended, recites in part:

one or more of the dormant access terminals not acknowledging receipt of the short data bursts; and

one or more of the non acknowledging dormant access terminals receiving the short data bursts using re-assigned common traffic channels.

Applicant submits that this is neither taught nor suggested by the Wang reference and should therefore be allowable over Wang. Dependent claims 40, 43, 44, 47-50, 57-60, 67, and 68-70 depend from and further limit independent claim 39 and should therefore overcome any rejections based on the Wang reference as well.

Claim 77, as amended, recites in part:

wherein if one or more access terminals do not acknowledge receipt of the short data bursts, then one or more access points are adapted to re-assign one or more non-acknowledging access terminals to different corresponding common traffic channels;

wherein one or more access points are adapted to retransmit the short data bursts to one or more non-acknowledging access terminals using the re-assigned common traffic channel

Applicant submits that this is neither taught nor suggested by the Wang reference and should therefore be allowable over Wang. Dependent claim 78 depends from and further limits independent claim 77 and should therefore overcome any rejections based on the Wang reference as well.

Original independent claims 1, 39, and 77 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,456,604 to Lee et al. ("Lee '604"). Applicant has amended claims 1, 39, and 77 and submits that these claims, as amended, are not anticipated by Lee '604. As stated above, the PTO provides in MPEP § 2131 that, "[t]o anticipate a claim, the reference must teach every element of

the claim." Therefore, with respect to claims 1, 39, and 77, to support a rejection under 35 U.S.C. §102(e), the Lee '604 reference must contain all elements of the claim.

Claim 1, as amended, recites in part:

- one or more of the access points detecting that one or more of the dormant access terminals did not acknowledge receipt of the short data bursts;
- one or more of the access points re-assigning one or more of the non-acknowledging dormant access terminals to different corresponding common traffic channels; and
- one or more of the access points re-transmitting the short data bursts to one or more of the non-acknowledging dormant access terminals using the re-assigned common traffic channels.

Applicant submits that this is neither taught nor suggested by the Lee '604 reference. Therefore, claim 1 should be allowable over Lee '604. Dependent claims 2, 3, 5-12, 17-23, 27, depend from further limit the independent claim 1 and should therefore overcome any rejections based on the Lee '604 reference as well.

Claim 39, as amended, recites in part:

- one or more of the dormant access terminals not acknowledging receipt of the short data bursts; and
- one or more of the non acknowledging dormant access terminals re-receiving the short data bursts using re-assigned common traffic channels.

Applicant submits that this is neither taught nor suggested by the Lee '604 reference and should therefore be allowable over Lee '604. Dependent claims 40, 43, 44, 47-50, 57-60, 67, and 68-70 depend from and further limit independent claim 39 and should therefore overcome any rejections based on the Lee '604 reference as well.

Claim 77, as amended, recites in part:

- wherein if one or more access terminals do not acknowledge receipt of the short data bursts, then one or more access points are adapted to re-assign one or more non-acknowledging access terminals to different corresponding common traffic channels;

wherein one or more access points are adapted to retransmit the short data bursts to one or more non-acknowledging access terminals using the re-assigned common traffic channel

Applicant submits that this is neither taught nor suggested by the Lee '604 reference and should therefore be allowable over Lee '604. Dependent claim 78 depends from and further limits independent claim 77 and should therefore overcome any rejections based on the Lee '604 reference as well.

Rejections Under 35 U.S.C. §103

Previous claims 4, 42, and 80 were rejected under 35 U.S.C. § 103 as being unpatentable over Lee '604 in view of U.S. Patent No. 6,289,217 to Hamalainen et al. ("Hamalainen"). The limitations formerly found in these claims have been incorporated into the respective independent claims. Applicant traverses any rejection of the independent claims 1, 39, or 77 based on a combination of the references cited above on the grounds that these references are defective in establishing a prima facie case of obviousness. The PTO recognizes in MPEP § 2142 that, "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that, in the present case, the examiner cannot factually support a prima facie case of obviousness for the following reasons.

The combined references do not teach the claimed invention.

Applicant submits that the references do not combine to teach the claimed limitations. 35 U.S.C. §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

On page 6, 3rd paragraph of the Office Action, the Examiner cites Fig. 3 and column 9, lines 46-65 of Hamalainen as teaching, "reassigning non-acknowledging dormant access terminals to different corresponding common traffic channels; and reassigned corresponding traffic channels are determined as a function of the carrier to interference ratios." The cited portion of Hamalainen does not teach or suggest

reassigning dormant access terminals to different corresponding common traffic channels. The carrier to interference ratio ("C/I") is discussed in Column 10 of Hamalainen. However, this portion of Hamalainen discusses C/I in the context of changing a modulation based on the C/I ratio (see, e.g., column 10, lines 15-17).

As stated previously, claim 1 requires, "one or more of the access points re-assigning one or more of the non-acknowledging dormant access terminals to different corresponding common traffic channels." Also, as stated previously claim 39 requires, "one or more of the non acknowledging dormant access terminals re-receiving the short data bursts using re-assigned common traffic channels." The remaining independent claim, claim 77, requires that, "wherein if one or more access terminals do not acknowledge receipt of the short data bursts, then one or more access points are adapted to re-assign one or more non-acknowledging access terminals to different corresponding common traffic channels." Since none of these elements are taught or suggested by the cited combination of references, a *prima facie* showing of obviousness has not been made. For at least this reason, claims 1, 39, and 77 should be allowable over the art as cited.

The combination of references is improper.

The MPEP also provides in §2142 that:

the examiner must step backward in time and into the shoes worn by the hypothetical person of ordinary skill in the art= when the invention was unknown and just before it was made.....Knowledge of the applicant's disclosure must be put aside ... impermissible hindsight must be avoided.

Here, neither Lee '604 nor Hamalainen teaches or suggests, the desirability of the combination of any of claims 1, 39, or 77. Thus, there is no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection of these claims. In this context, the MPEP further provides at § 2143.01 that, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. "

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it appears that the combination of the Lee '604 and Hamalainen references arises from hindsight based on the invention without a showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. For this reason, at least, the Examiner's burden of factually supporting a prima facie case of obviousness has not been met, and the rejection under 35 U.S.C. §103 is not applicable to claims 1, 39, or 77.

Since a prima facie case of obviousness with respect to claims 1, 39, and 77 has not been shown, the claims should be allowable over the art cited against them. The pending dependent claims, which depend from and further limit claims 1, 39, and 77, should be allowable as well for at least the same reasons. Therefore, all pending claims should be allowable over Wang, Lee '604, Hamalainen, U.S. Patent No. 6,218, 008, U.S. Patent Application No. 2001/0040877, and/or combinations thereof.

New Claims

Claim 81 has been added. Applicant submits that this claim is allowable over the references cited in the Office Action because none of the references, either alone or in combination with another cited reference, teaches or suggests every element of claim 81.

Conclusion

It is clear from all of the foregoing that all pending claims are in condition for allowance. If the Examiner believes that any further amendments are necessary to place the application in condition for allowance, (s)he is invited to contact the undersigned.

Respectfully submitted,



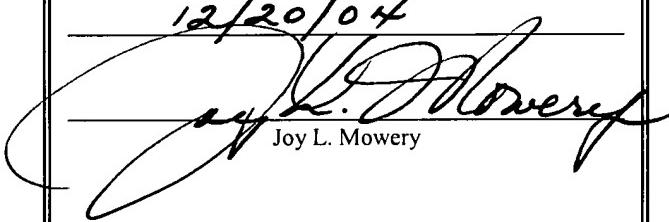
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